

REMARKS

Claims 75 and 84 have been amended in order clearly to distinguish a document already of record which appears possibly to coincidentally anticipate the independent claims as previously drawn. This document, U.S. 5,094,927 (the '927 patent), was cited in an Information Disclosure Statement received in the U.S. PTO 10 October 2003, and acknowledged by the Examiner on 26 January 2004. This document describes an inorganic electrolyte sandwiched between two electrodes which are constructed of nickel or palladium, two of the metals used as a support foil in the present application. Because the function of these metal foils in the '927 patent is different from the functions served in the present application (they are electrodes, not a support for an electrolyte), the relevance of this document did not become apparent until the coincidental construction features were pointed out in a non-U.S. counterpart. Applicants are filing a Request for Continuing Examination in order to ensure that claims of valid scope issue.

It is not believed that the amendment to the claims affects the nature of the rejections that are currently outstanding. Applicants' response to these rejections is similar to that set forth previously. These rejections are addressed as follows:

The Rejection Under 35 U.S.C. § 112, Paragraph 2

This rejection was applied to claims 84-91 based on objections solely to claim 84. The first objection is directed to the use of the trade name "Nafion[®]." The Office considers that the claim scope is uncertain since the trademark cannot be used to identify any particular material or product. Respectfully, as used in claim 84, the trademark is not a claim limitation; it simply refers to a

designation on an accompanying figure. Therefore, the rationale for rejection is not germane in this case.

The Office further objects to the inclusion of a figure in the claims. Respectfully, as the figure is *in* the claim, the claim *is* complete in itself. There is no reference to something not in the claim. No reference to the text is needed. Therefore, it is believed the inclusion of the figure in the claim is proper.

Based on the foregoing, applicants believe the rejection under this statutory section may be withdrawn.

The Art Rejections

The rejection of claims over the combination of Smotkin, *et al.* (U.S. 5,846,669) in combination with Norby, or Crome, or Kwang (sic, Ryu), or Dorthe (sic, Lybye).

The text of the rejection on this basis is absolutely identical verbatim to that set forth in the previous Office action. Applicants have already responded to this rejection and incorporate their previous answer by reference to the Response filed 9 January 2006, including the declaration attached thereto.

Similarly, the rejection of all claims based on WO 98/21777 in combination with the same secondary documents, has simply been repeated verbatim and applicants' answer in the Response filed 9 January 2006, along with the accompanying declaration is incorporated in this response by reference.

The Examiner has, however, responded to the arguments made by applicants, and these responses, set forth in paragraphs 15-22 of the Office action are addressed as follows:

With respect to paragraph 15, the amended claims specify a “proton-conducting membrane” which is equivalent to an electrolyte. Therefore, “electrolyte” is positively recited.

With respect to paragraphs 16 and 17, the requirement that the proton-conducting membrane be designed to serve as an electrolyte in a fuel cell *does* confer certain structural features – it must, indeed, be a proton-conducting membrane. So the structural limitations are set forth twice. With regard to the statement in paragraph 17 that “if the prior art structure is capable of performing the intended use, then it meets the claim” is only partly true. The prior art structure must also meet the structural limitations set forth in the claim. The Office has cited no prior art structure that meets these limitations – *i.e.*, a single metal or metal hydride support wherein one or both faces of the support is coated with an electronically insulating proton-conducting coating, which coating consists of an inorganic material that contains no liquid phase and has a specified ASR in a specified temperature range.

Paragraph 18, stating that documents cannot be attacked individually where rejections are based on combinations, appears irrelevant to applicants’ arguments as the combinations have been addressed in the previous response.

With respect to paragraph 19, the distinction from Smotkin is not the intended purpose, but rather, for example, the lack of a liquid phase. Smotkin does not even meet this limitation.

With respect to paragraph 20, applicants believe the Office is mistaken in that some motivation must be found to combine documents. Combining the documents on the basis of the teaching of the invention itself is not appropriate.

With respect to paragraph 21, the Office appears to be confusing the availability in the art of materials that are combined in an inventive way with availability of the combination.

With respect to paragraph 22, this appears to be identical as an argument to that set forth in paragraph 18, which has been addressed above.

The remaining responses to applicants arguments as presented in prior Office actions appear repetitious of the foregoing and further comment is not needed.

Conclusion

Applicants have repeatedly shown that the claimed proton-conducting membrane is novel and inventive over the art. No additional grounds of rejection have been raised. Therefore, applicants respectfully request that the pending claims, claims 75-82 and 84-91 be passed to issue or that the outstanding rejections be maintained so that an appeal may properly be filed.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket No. 491712000100.

Respectfully submitted,

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